

REMARKS

The Claims in the case are 35-46. These are supported by the specification and original examples 1, 2, 3, 4, 5, 6, 9, 12, 13, 14 and 15. Compounds disclosed in Examples 7 and 8 (to the dimethyl amino propoxy side chain; Examples 10 and 11, to the diethyl amino ethoxy side chain; and Examples 16 and 17, to the 4-methyl piperazino side chain; are not claimed. No new matter is included within the newly added claims.

This case has been rejected, and there are two issues: the lack of novelty under Section 102 over Plantier and the obviousness under Section 103 over Neuenschwander. Both these issues have been overcome by Applicants' amendments in this response, and it is urged that the case is allowable.

Section 102 rejection

The Examiner is respectfully requested to reconsider and withdraw the rejection under section 102, as the reference Plantier does not anticipate any species in the newly added claims in the application. Plantier discloses indole derivatives having (bis) N,N-diethyl-phenylene oxy substituents. Applicants claim compounds in which the substituents on the phenyleneoxy chain are either piperidinyl, pyrrolidinyl or pyridinyl. These compounds are not disclosed in Plantier. Accordingly, the Plantier reference is not anticipatory and should be withdrawn.

Section 103 rejection

The Neuenschwander reference cited for the rejection based on 35 U.S.C. 103 does not provide a reasonable expectation for successfully producing Applicants' claimed compounds, as newly presented in this amendment. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. 103 be withdrawn.

The Neuenschwander reference relates to (as referring to Applicants' invention) an indole ring, connected to a phenyl ring, connected through an oxygen, to the "A" ring, which although primarily a "bridged bicyclic core with a nitrogen bridging atom", also mentions the 1,3-piperazine ring and the imidazole ring, Col 2, bottom of page. The Examiner is incorrect in stating that Neuenschwander also discloses the piperidine ring as a possibility for "A".

Applicants' preferred subset of compounds, found at page 9 of the specification, encompasses only monocyclic core compounds. Specifically mentioned are seven monocyclic

USSN 09/820,438, filed 3/29/01

- 5 -

moieties: piperazino, N-methyl piperazino, pyrrolidino, N-methyl pyrrolidino, pyridyl, thiazoyl, and piperidino. In the Examples, only four of these rings are disclosed, viz, pyridinyl, pyrrolidinyl, piperidinyl, and piperazinyl. The three rings, pyridinyl, pyrrolidinyl, piperidinyl, are encompassed within the newly presented claims. The preferred genus now found in the Claims is supported by the specification and original examples 1, 2, 3, 4, 5, 6, 9, 12, 13, 14 and 15.

The significant structural differences between Applicants' newly presented claims and the Neuenschwander compounds, together with the completely different activity (Neuenschwander teaches the use of reducing serum cholesterol in the body without significantly reducing metabolite synthesis) permit the inference of obviousness to be overcome. The teaching of the reference Neuenschwander taken as a whole, does not suggest the claimed compounds within Applicants' amended claims. The combinations taught in Neuenschwander do not suggest the structure of Applicants' monocyclic compounds as presently claimed.

See Ex Parte Clapp, 227 USPQ 972 (PTOBd., 1991) "... in establishing a prima facie case of obviousness under 35 USC 103 it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention." Applicants teaching of the preferred subset of monocyclic compounds are not suggested by the reference. The rejection lacks reasoning based on sound scientific principles. See Ex Parte Kranz 19 USPQ2d 1216,1218 (PTO Bd., 1991) "obviousness is tested by what the combined teachings of the references would have suggested to one of ordinary skill in the art [...] Before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles". The Applicants requests careful reconsideration of the rejections lodged against the Applicants' invention.

Conclusion

The Examiner is respectfully requested to reconsider and withdraw the rejections. Applicants submit the Application is now in condition for allowance and respectfully requests early notice to that effect.

Should the Examiner feel that telephonic communication with Applicants' representative would further the prosecution of the instant application, he is invited to telephone the undersigned.